

## **REMARKS**

### **Formal Matters**

Applicant wishes to thank the Examiner for the attention accorded to the instant application.

Claims 1-3 are pending in the application. Claims 1 and 2 are amended to more clearly recite the invention.

Applicant requests that this amendment submitted under 37 CFR § 1.114 along with a Request for Continued Examination (RCE) be entered and the examination of the application be continued.

### **Summary of Telephone Interview**

Applicant thanks the Examiner for the telephone interview of June 12, 2007. In this interview, the Examiner agreed that applicant's proposed amendments, faxed to the Examiner on June 6, 2007 and submitted herein, would overcome his rejection of claims 1-3 under 35 U.S.C. § 101 as reciting non-statutory subject matter, that is, the phrase "endless-recording". Also, the Examiner requested that the phrase "capable of" in claims 1 and 2 be amended to "configured to" because "capable of" is indefinite. The Examiner indicated that a new search would be needed because his prior searches did not search for "endless-recording" memory.

### **Claim Rejections – 35 U.S.C. § 101**

The Examiner has rejected claims 1-3 under 35 U.S.C. § 101 because claim 1 recites "a plurality of memories, each of which is for endless-recording" but memory is not able to store an unlimited amount of data. Applicant amends claim 1 to include the phrase "wherein when one of the plurality of memories becomes full during the telephone conversation, the audio data in the full memory is overwritten and endless-recording the audio data continues", and amends claim 2

to correspond to claim 1. Applicant respectfully submits that claims 1 and 2 are patentable. Claim 3 depends from claim 1, incorporating all of the features and limitations of its base claim. Thus claim 3 is patentable for at least the reasons that claim 1 is patentable. Applicant requests that this rejection be withdrawn.

### **Claim Rejections – 35 U.S.C. § 103**

The Examiner has rejected claims 1-3 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,732,349 to Sanpei et al. (hereinafter “Sanpei”) in view of U.S. Patent No. 6,658,496 to Minakata et al. (hereinafter “Minakata”), and further in view of U.S. Patent No. 6,222,909 to Qua et al. (hereinafter “Qua”). This rejection should be withdrawn based on the comments and remarks herein.

Among the problems recognized and solved by Applicant’s claimed invention is the need for a portable phone having a recording function by which a current conversation can be recorded and a portion reproduced while simultaneously recording the continuation of that current conversation. Applicant’s invention, as recited in the claims, is a portable phone having at least a plurality of memories, a switching unit and a reproducing unit. Upon initiation of a conversation on the inventive portable phone, one selected memory of the plurality of memories automatically begins recording. The conversation is endless-recorded because when the selected recording memory becomes full, the previously recorded data in this memory is replaced by new conversation data. When a user desires to preserve a conversation or portion thereof, he or she instructs the phone to begin recording in a second memory so that the data in the initially selected memory is saved and not replaced by new data. Recording in this second memory is also endless so that when this second memory is full, the conversation data overwrites the previously recorded data in that second memory. Further, a user can instruct the phone to

reproduce or play back the contents of the initially selected memory while simultaneously continuing to record the current conversation in the second memory. Thus applicant's inventive apparatus is able to endless-record a current telephone conversation, and also play back a portion of the conversation while simultaneously endless-recording the continuation of the current conversation.

The Examiner states that Sanpei does not disclose or suggest either a plurality of memories or a reproducing unit. However, the Examiner contend that Minakata discloses a plurality of memories and Qua discloses a reproducing unit. Applicant disagrees.

Minakata discloses a flash memory including a first flash memory nondetachably enclosed in an IC recorder and a second flash memory detachable from the IC recorder (column 2, lines 64-67). Minakata further discloses "[i]f the second flash memory 9b is loaded on the IC recorder 1 and the first flash memory 9a is charged to its full capacity, the speech data is written in the second flash memory 9b." (column 3, lines 38-41) Hence, Minakata teaches that if one memory is full, and another memory is available, the speech data is written to the other memory. Minakata provides no other procedure when one memory is full, and therefore, in effect, teaches away from overwriting the full memory when it becomes full. Consequently, Minakata does not disclose or suggest that when a memory becomes full during the telephone conversation, the audio data in the full memory is overwritten and recording continues, as recited in claim 1.

Qua does not overcome this deficiency, and the Examiner does not state otherwise. In particular, Qua does not teach or suggest a full memory, and does not teach or suggest a procedure for dealing with a full memory. Thus, the hypothetical combination of Sanpei, Minakata and Qua, taken separately or in any combination, does not disclose or suggest all of the features and limitations recited in independent claim 1 so that claim 1 is patentably

distinguishable over the art of record in the application.

It has been held by the courts that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As illustrated above, neither Sanpei nor Minakata nor Qua, taking singly or in any proper combination, teach or suggest all of the features of independent claim 1. Hence, a *prima facie* case of obviousness has not been established. Therefore, Applicant respectfully submits that independent claim 1 is patentably distinguishable over the art of record in the application. Claims 2 and 3 depend from claim 1, incorporating all of the features of the base claim. Accordingly, claims 2 and 3 are patentably distinguishable over the art of record for at least the reasons, discussed above, that claim 1 is patentably distinguishable over the art of record. Withdrawal of this rejection is earnestly requested.

#### **Conclusion**

For the foregoing reasons, Applicant respectfully submits that all pending claims 1-3 are now in condition for allowance, and kindly solicits an early and favorable indication of allowability. If the Examiner has any reservation in allowing the claims, and believes a telephone interview would advance prosecution, he is kindly requested to telephone the undersigned at his earliest convenience.

Respectfully submitted,



Katherine R. Vieyra  
Registration No. 47,155

Scully, Scott, Murphy & Presser, P.C.  
400 Garden City Plaza, Suite 300  
Garden City, New York 11530  
KRV:vh